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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		21987-00054-US	
		Application Number	Filed
		09/817,123-Conf. #1669	March 27, 2001
		First Named Inventor Katsuki Hazama	
		Art Unit	Examiner
		3714	R. E. Mosser
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>44,163</u></p> <p> Signature</p> <p><u>Larry J. Hume</u> Typed or printed name</p> <p><u>(202) 331-7111</u> Telephone number</p> <p><u>March 2, 2006</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

Docket No.: 21987-00054-US  
(PATENT)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Katsuki Hazama

Confirmation No.: 1669

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MAR 02 2006

Application No.: 09/817,123

Filed: March 27, 2001

Art Unit: 3714

For: GAME MACHINE AND INFORMATION  
COMMUNICATION SYSTEM USING DATA  
CARRIER

Examiner: R. E. Mosser

**ARGUMENTS SUBMITTED WITH PRE-APPEAL BRIEF REQUEST FOR REVIEW**

March 2, 2006

MS AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Claims 1, 6-15, 39, and 40 remain pending in this application and are the subject of this Pre-Appeal Brief Request for Review, filed concurrently with the Notice of Appeal. Claims 1 and 6 are independent, and these Arguments will focus only on the independent claims.

The Appeal Conference members' attention is invited to the "Request for Reconsideration of Final Rejection" filed on February 2, 2006 for a more complete discussion of the deficiencies of the Final Rejection.

**I. Gilboa, Zalewski, and Hikawa do not Teach or Suggest all Claim Limitations**

Withdrawal of the rejection of claims 1, 6, 7, 10, 11, 15 and 39-40 under 35 U.S.C 103(a) as being unpatentable over Gilboa (US 5,853,327) in view of Zalewski (US 5,991,693) and Hikawa et al (US 5,526,306) is requested. The Examiner has failed to meet his burden in establishing a *prima facie* case of obviousness. The applied art does not teach or suggest all the claimed limitations, in particular, the limitations of independent claims 1 and 6.

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**A. Claim 1****1. "Means for notifying the first control device that the received driving electric power has reached a predetermined quantity of electric power"**

The applied art, taken alone or in combination, does not teach or suggest a game apparatus which includes, among other features, "means for notifying the first control device that the received driving electric power has reached a predetermined quantity of electric power...", as recited in independent claim 1.

Gilboa is directed to a combination computer game and board game including a game board, a plurality of toy figures selectably positionable by a player with respect to the game board, an apparatus for automatically and non-discretely sensing the location of the toy figures relative to the game board and responsively actuating an audio/visual display sequence. Gilboa's apparatus is operative in a wireless mode of operation.

Gilboa also discloses that an LC circuit is associated with each cell on the game table and a sensing antenna is associated with the entire game table. Playing pieces or game or toy figures, each including a transponder, are located on some of the cells of the game table. A plurality of excitation coils generate query signals which are received by the transponders of all playing pieces located on cells at which a query signal is generated. The transponder in the playing piece then generates a coded answer signal, preferably having a frequency unique to the piece or the type of piece, which is received by the sensing antenna. The antenna, which may receive more than one answer signal, generates a sensor signal responsive to the answer signal.

Contrary to the Examiner's assertions, Gilboa does not teach or suggest any means for notifying the reader or control device that the received driving electric power has reached a predetermined quantity of electric power. The "response" by Gilboa is purely in the form of a resonance signal formed by the LC circuit.

**2. Gilboa does not "implicitly" teach "means for notifying the first control device that the received driving electric power has reached a predetermined quantity of electric power"**

MPEP 2144.01 allows invocation of implicit disclosure when a proper inference can be drawn by a person with skill in the art from the teachings of the reference itself. This is not the case with Gilboa.

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Appellants point out that the "response" by Gilboa is purely in the form of a resonance signal formed by the LC circuit. As such, this circuit is going to respond to a variety of different levels of received electrical power. In other words, each piece is going to respond all the time at some point, irrespective of the quantity of electrical power. So the fact that you get a "response" says nothing about the *amount* of electrical power that has been stored/received.

In fact, as can be seen at Gilboa col. 13, line 55, Gilboa's system separately determines the signal power from each piece.

Appellants again pose the following question to the Examiner -- Why would that have to happen if all pieces had all reached the same "predetermined" quantity of electrical power?

Stated another way, each piece in Gilboa responds differently; this is not the same as Appellants' claimed invention, where each piece has to reach the "predetermined" quantity of electrical power, and notify the control unit after reaching this level of power.

The Examiner admits that Gilboa is silent regarding the use of a control unit with associated memory, but offers Zalewski as disclosing a control unit with game pieces. However, the Examiner also admits that Zalewski is silent regarding the use of a coil resonance system or in the locating of the game pieces on a game body. Thus, Zalewski does not make up for Gilboa's deficiencies with respect to the claimed means for notifying.

#### B. Claim 6

1. "Means for notifying the first control device that the received driving electric power has reached a predetermined quantity of electric power"

The applied art, taken alone or in combination, does not teach or suggest an information communication system which includes, among other features, "...means for providing a notification that the received driving electric power has reached a predetermined quantity of electric power..."

In the interests of brevity, and due to the similarity of this particular limitation to that in claim 1, Appellants invite the Examiner's attention to paragraph I. A. 1. above, in which the deficiencies of the applied art in this regard have been identified.

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2. **Gilboa does not “implicitly” teach “means for providing a notification that the received driving electric power has reached a predetermined quantity of electric power”**

In the interests of brevity, Applicants invite the Examiner’s attention to paragraph I. A. 2. above, in which the deficiencies of the applied art in this regard have been identified.

## **II. Motivation is Lacking – Gilboa Teaches Away**

Applicants submit that a person with skill in the art would not be motivated to combine Gilboa and Zalewski in the manner suggested to form Appellants’ claimed invention, since the portion of Gilboa relied upon by the Examiner as teaching the means for notifying teaches away from the invention claimed in the claims on appeal.

In particular, and with respect to Gilboa’s embodiment in FIG. 10 and col. 11, line 16 *et seq.*, it appears that the Examiner is relying upon and combining Gilboa’s “no power” embodiment (*i.e.*, where Gilboa uses a resonance circuit in lieu of a battery) with the other references to show a more advanced control unit. But without Gilboa’s battery, there is no data transfer, and the system is incapable of working as Appellants have disclosed and claimed.

Therefore, Appellants submit that the Examiner is mixing and matching incompatible elements from the reference, using impermissible hindsight to do so. In other words, this section of *Gilboa clearly teaches away* from using a battery source, which would be “implicitly” required to implement the teachings of Zalewski, which the Examiner offers as teaching using a memory.

Appellants submit that the resonant circuit of Gilboa would clearly not retain sufficient energy to power a transmitter or memory, for example, because Gilboa’s resonant circuit would immediately “collapse” and reradiate, given the underlying physics of RLC resonance phenomenon.

Appellants again submit that this is an overreaching interpretation of the applied art to assert that the above-cited limitation is “implicitly providing the means for notifying...”, and that any attempt to do so relies upon impermissible hindsight, using Appellants’ disclosure against them.

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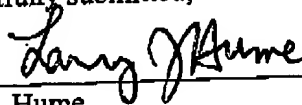
Conclusion

The Examiner has not met his burden in establishing a *prima facie* case of unpatentability not only because the combination of applied art does not teach or suggest all the claimed limitations, as discussed above, but because of deficient motivation to combine the references in the manner suggested by the Examiner. Withdrawal of the rejections and allowance of claims 1, 6-15, 39, and 40 are respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to CBLH Deposit Account No. 22-0185, under Order No. 21987-00054-US, from which the undersigned is authorized to draw.

Respectfully submitted,

By



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